REMARKS

Claims 1, 2, and 4-31 are pending and under consideration. Claim 13 has been amended. Support for the amendment to claim 13 may be found in the claim as originally filed. Claim 5 and 11 have been amended to include substantially the subject matter of claim 1, while claims 18, 19, 21, 22, and 26 have been amended to include substantially the subject matter of claim 14, and, in the case of claim 19, claim 17 as well.

This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Since the amendments are primarily cosmetic, they are not being made for any reason of patentability. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Objections to the Claims:

Claim 13 was objected to for an informality. Claim 13 was amended in substantial accord with the Examiner's suggestion. The Examiner's suggestion is appreciated. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 102:

Claims 1, 2, 8, 9, 10, 14, 15, 16, 23, 24, 25, 29, 30 and 31 were rejected under 35 U.S.C. § 102(a) as anticipated by Ruch et al. "Medical Document Anonymization with a Semantic Lexicon," (hereinafter "Ruch"). The rejection is traversed.

Claim 1 recites,

An anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold.

Ruch neither teaches, discloses, nor suggests "an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," as recited in claim 1. Ruch, in fact, mentions no "predetermined threshold" at all. Ruch, rather is describing tagging a word properly with one or the other of a pair of tags, *idm* and *id*, in column 1, paragraphs 2 and 3, at page 3. If the word is a lexeme, it earns the *idm* designation, as described at lines 21 and 22 of column 1 on page 3. If the word is a human proper noun, *id* is applied, as described at lines 22 and 23 of column 1 on page 3. If it is neither, it is not tagged. There's no "predetermined threshold," as recited in claim 1. A word is

either a lexeme, or a proper human noun, or neither. It is not as though a word can reach a threshold of "lexeme-ness."

Nor is Ruch "changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," as recited in claim 1, either. Ruch, rather, is only tagging lexemes and human proper nouns, not changing them, as described at lines 6 and 7 of column 1 on page 3. Ruch merely seeks to remove some of the ambiguity from identifying the sense of a word, as described at lines 8 and 9 of column 1 on page 3, by providing the right tag. Although Ruch does mention an extraction module at lines 8-14 of column 2 on page 4, extraction is not changing, it is extracting, i.e. removing. No mention is made of "changing a name of the person in the input document," as recited in claim 1, let alone "having a specificity which is greater than a predetermined threshold," at all.

Claim 1 recites further,

Wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions.

Ruch neither teaches, discloses, nor suggests "wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions," as recited in claim 1.

Ruch, in particular, "extracts" no "surrounding expressions of the person's name from said input document," at all. Ruch, rather is describing tagging a word properly with one or the other of a pair of tags, *idm* and *id*, in column 1, paragraphs 2 and 3, at page 3. If the word is a lexeme, it earns the *idm* designation, as described at lines 21 and 22 of column 1 on page 3. If the word is a human proper noun, *id* is applied, as described at lines 22 and 23 of column 1 on page 3. If it is neither, it is not tagged. Ruch "extracts" no "surrounding expressions of the person's name from said input document," because expressions surrounding a word would have no bearing on whether the word was a lexeme or a human proper noun or not. It is not as though the identity of the word as a lexeme or a human proper noun will depend on "surrounding expressions of the person's name," after all. A word is either a lexeme, or a human proper noun, or none of the above.

Claim 1 recites further,

Said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name.

Ruch neither teaches, discloses, nor suggests "said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name," as recited in claim 1. Ruch, rather, describes no "surrounding expression of a degree of specificity higher than a predetermined threshold," at all, as discussed above.

Finally, to serve as an anticipating reference, the reference must enable that which it is asserted to anticipate. "A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CA FC 2003).

Ruch, here, would not constitute an enabling disclosure if it were an application for a patent. Ruch, in particular, is essentially a survey or an overview of work that was done previously, or so the authors claim, without describing how to make and use the invention, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, as required by 35 U.S.C. § 112. Since Ruch does not enable the claimed invention, Ruch cannot anticipate the claimed invention. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 1, 2, 8, 9, and 10 depend from claim 1 and add further distinguishing elements. Claims 1, 2, 8, 9, and 10 are thus also submitted to be allowable. Withdrawal of the rejection of claims 1, 2, 8, 9, and 10 is also earnestly solicited.

Claims 14, 15, 16, and 25:

Claim 14 recites,

An anonymity setting processing step of rewriting the name of the person with an

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anonymity expression in said input document which has a specificity higher than a predetermined threshold.

Ruch neither teaches, discloses, nor suggests "an anonymity setting processing step of rewriting the name of the person with an anonymity expression in said input document which has a specificity higher than a predetermined threshold," as discussed above with respect to the rejection of claim 1.

Claim 14 recites further,

Wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of intensity at which the person can be specified with the extracted individual surrounding expressions.

Ruch neither teaches, discloses, nor suggests "wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of intensity at which the person can be specified with the extracted individual surrounding expressions," as discussed above with respect to the rejection of claim 1.

Claim 14 recites further,

Said anonymity setting processing step sets, when there is a surrounding expressions of a degree of specificity higher then a predetermined threshold, anonymity for said surrounding expression and the person's name.

Ruch neither teaches, discloses, nor suggests "said anonymity setting processing step sets, when there is a surrounding expressions of a degree of specificity higher then a predetermined threshold, anonymity for said surrounding expression and the person's name," as discussed above with respect to the rejection of claim 1.

Finally, the final Office Action has made out no prima facie case of anticipation with respect to the disclosure of the Ruch reference, and Ruch is not an enabling reference, as discussed above with respect to the rejection of claim 1. Claim 14 is submitted to be allowable as well, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 14 is earnestly solicited.

Claims 15, 16, and 25 depend from claim 14 and add further distinguishing elements. Claims 15, 16, and 25 are thus also submitted to be allowable. Withdrawal of the rejection of claims 15, 16, and 25 is also earnestly solicited.

Claims 29 and 30:

Claim 29 recites,

An anonymity setting processing step of rewriting the person's name with an anonymity expression in said input document which has a higher specificity than a predetermined threshold.

Ruch neither teaches, discloses, nor suggests "an anonymity setting processing step of rewriting the person's name with an anonymity expression in said input document which has a higher specificity than a predetermined threshold," as discussed above with respect to the rejection of claim 1.

Claim 29 recites further,

Wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating at what degree of intensity the person can be specified with the extracted individual surrounding expressions.

Ruch neither teaches, discloses, nor suggests "wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating at what degree of intensity the person can be specified with the extracted individual surrounding expressions," as discussed above with respect to the rejection of claim 1.

Finally, claim 29 recites,

Said anonymity setting processing step sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and person's name.

Ruch neither teaches, discloses, nor suggests "said anonymity setting processing step sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and person's name," as discussed above with respect to the rejection of claim 1.

Finally, the final Office Action has made out no prima facie case of anticipation with respect to the disclosure of the Ruch reference, and Ruch is not an enabling reference, as discussed above with respect to the rejection of claim 1. Claim 29 is submitted to be allowable as well, for at least those reasons as discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 29 is earnestly solicited. Claim 30 depends from claim 29 and adds further distinguishing elements. Claim 30 is thus also believed to be allowable.

Claim 31:

> Claim 31 recites,
>
> Rewriting the expression with an anonymous expression if the degree of specificity is greater than a predetermined threshold.

Ruch neither teaches, discloses, nor suggests, "rewriting the expression with an anonymous expression if the degree of specificity is greater than a predetermined threshold," as discussed above with respect to the rejection of claim 1.

Finally, the final Office Action has made out no prima facie case of anticipation with respect to the disclosure of the Ruch reference, and Ruch is not an enabling reference, as discussed above with respect to the rejection of claim 1. Claim 31 is submitted to be allowable as well, for at least those reasons as discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 31 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 4, 6, 7, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruch in view of Mani et al. "Identifying Unknown Proper Names in Newswire Text," (hereinafter "Mani"). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 4, 6, and 7 depend from claim 1 and add further distinguishing elements. Ruch neither teaches, discloses, nor suggests "an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," "wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions," or "said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name," as discussed above with respect to the rejection of claim 1.

Mani does not either, and thus cannot make up for the deficiencies of Ruch with respect to claims 4, 6, and 7. Mani, rather, is concerned strictly with identifying unknown proper names for information retrieval or as a precursor for more knowledge intensive tasks such as data extraction, as described in the Abstract. Making names anonymous after identifying them for data extraction purposes would have served no purpose for Mani. Thus, even if Ruch and Mani were combined, as proposed in the final Office Action, the claimed invention would not result.

Mani, furthermore, would not constitute an enabling disclosure if it were an application for a patent. Mani, in particular, is essentially a survey or an overview of work that was done previously, or so the authors claim, without describing how to make and use the invention, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, as required by 35 U.S.C. § 112. As one example of the deficiencies of Mani with respect to the enablement requirement, the algorithm described at section 3 is provided nowhere. Since Mani does not enable the claimed invention, Mani cannot anticipate the claimed invention. Claims 4, 6, and 7 are thus also submitted to be allowable. Withdrawal of the rejection of claims 4, 6, and 7 is also earnestly solicited.

Claims 17 and 20:

Claims 17 and 20 depend from claim 14 and add further distinguishing elements. Ruch neither teaches, discloses, nor suggests "an anonymity setting processing step of rewriting the name of the person with an anonymity expression in said input document which has a specificity higher than a predetermined threshold," "wherein said specificity calculating step extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of intensity at which the person can be specified with the extracted individual surrounding expressions," or "said anonymity setting processing step sets, when there is a surrounding expressions of a degree of specificity higher then a predetermined threshold, anonymity for said surrounding expression and the person's name," as discussed above with respect to the rejection of claim 14.

Mani does not either, and thus cannot make up for the deficiencies of Ruch with respect to claims 17 and 20. Thus, even if Ruch and Mani were combined, as proposed in the final Office Action, the claimed invention would not result. Finally, Ruch is not an enabling reference, as discussed above with respect to the rejections of claims 4, 6, and 7. Claims 17 and 20 are thus also submitted to be allowable. Withdrawal of the rejection of claims 17 and 20 is also earnestly solicited.

Claims 12, 13, 27, and 28:

Claims 12, 13, 27, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ruch in view of U.S. Patent No. 6,785,812 to Botham, Jr. et al., (hereinafter "Botham, Jr."). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 12 and 13 depend from claim 1 and add further distinguishing elements. Ruch neither teaches, discloses, nor suggests "an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," "wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions," or "said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name," as discussed above with respect to the rejection of claim 1.

Botham, Jr. does not either, and thus cannot make up for the deficiencies of Ruch with respect to claims 12 and 13. In Botham, Jr., rather, the *entire* document will be encrypted, so there will be no need for "an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," let alone "wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified with the extracted individual surrounding expressions," or "said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name," recited in claim 1. In particular, as Botham, Jr. describes in the Abstract:

> The server then uses the encryption data to encrypt (220) the document and its permissions, and sends (224) the encrypted information to the client.

Thus, even if Ruch and Botham, Jr. were combined, as proposed in the final Office Action, the claimed invention would not result. Claims 12 and 13 are thus also submitted to be allowable. Withdrawal of the rejection of claims 12 and 13 is also earnestly solicited.

Claims 27 and 28:

Claims 27 and 28 depend from claim 14 and add further distinguishing elements. Ruch neither teaches, discloses, nor suggests "an anonymity setting processing unit changing a name of the person in the input document having a specificity which is greater than a predetermined threshold," "wherein said specificity calculating unit extracts surrounding expressions of the person's name from said input document, and calculates, for each surrounding expression, a degree of specificity for evaluating a degree of specificity at which the person can be specified

with the extracted individual surrounding expressions," or "said anonymity setting processing unit sets, when there is a surrounding expression of a degree of specificity higher than a predetermined threshold, anonymity for such surrounding expression and the person's name," as discussed above with respect to the rejection of claim 14.

Botham, Jr. does not either, and thus cannot make up for the deficiencies of Ruch with respect to claims 27 and 28, as discussed above with respect to the rejection of claims 12 and 13. Thus, even if Ruch and Botham, Jr. were combined, as proposed in the final Office Action, the claimed invention would not result. Claims 27 and 28 are thus also submitted to be allowable. Withdrawal of the rejection of claims 27 and 28 is also earnestly solicited.

Allowable Subject Matter:

The Applicant acknowledges with appreciation the indication that claims 5, 11, 18, 19, 21, 22, and 26 contain allowable subject matter. Claim 5 and 11 have consequently been amended to include substantially the subject matter of claim 1, while claims 18, 19, 21, 22, and 26 have been amended to include substantially the subject matter of claim 14, and, in the case of claim 19, claim 17 as well. All of claims 5, 11, 18, 19, 21, 22, and 26 are thus submitted to be allowable.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1, 2, and 4-31 are allowable over the cited references.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.
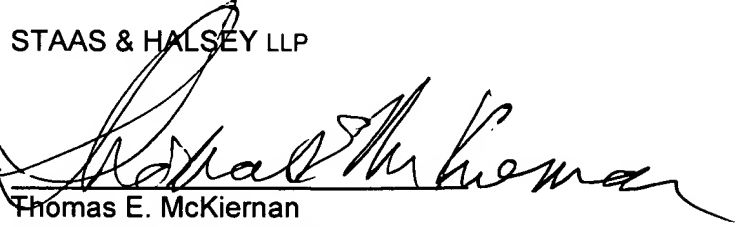
If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _16 MR 06_

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